

REMARKS

Claim 1-17 are pending in the application. Claims 1-13 and 17 have been canceled without prejudice or a disclaimer. Claims 14-17 stand rejected. Claim 14 is an independent claim.

Claims 15-16 have been amended to explicitly state that which was implicit in the original claim language. As such, the claim has not been narrowed and applicant makes no disclaimer through the amendment.

Drawings stand objected under 37 C.F.R. 1.83(a), as allegedly failing to illustrate every feature of the invention specified in claim 17. Claim 17 stands rejected under 35 U.S.C. 112, first paragraph, for allegedly failing to comply with the written description requirement. Applicant has canceled claim 17 without prejudice or a disclaimer. As such, applicant submits that both the objection and the rejection are moot. Applicant respectfully requests withdrawal of the objection and the rejection.

Claim 14 stands rejected under 35 U.S.C. '103(a), as allegedly being obvious over Madsen *et al.* (U.S. 2,616,581) ("Madsen") in view of Sheu (U.S. 6,068,147). Claim 14 recites, *inter alia*, **"an air vent valve having a first extending hole, a second extending hole coupled to the first hole, and a valve..."**

The United States Court of Appeals for the Federal Circuit held that to "reject claims in an application under section 103, [the Office Action] must show an un rebutted *prima facie* case of obviousness (*In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998) (citing *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995))). The *prima facie* case can be established only if the prior art references, among others, teach **all features** in the claims (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)), including those in

functional language (*In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ.2d 1429 (Fed. Cir. 1997) (holding that the patent applicant is free to recite features of an apparatus claim in functional language as long as the features in functional language are not inherent to the prior art)).

In rejecting claim 14, the Office Action appears to imply that the slit 33 of Madsen constitutes the second extending hole of claim 14, as the Office Action indicates that Madsen discloses “a bottle with... an air vent valve with first and second hole and a downward convex valve 33 in the manner claimed” (the present Office Action, page 5, paragraph 6).

Applicant respectfully submits that **a slit is not an extending hole**. As such, by disclosing a valve containing an air hole and **a slit**, the slit disposed at lower portion of the air hole, Madsen does not disclose “**an air vent valve having a first extending hole, a second extending hole coupled to the first hole, and a valve,**” as recited in claim 14.

Sheu, as read by applicant, discloses a plurality of air intake aiding plates (Figure 1-3). However, nowhere in Sheu is there a disclosure that any plate includes the “**an air vent valve having a first extending hole, a second extending hole coupled to the first hole, and a valve,**” as recited in claim 14.

As such, both Madsen and Sheu fails to disclose “**an air vent valve having a first extending hole, a second extending hole coupled to the first hole, and a valve,**” as recited in claim 14, and two references do not establish the *prim facie* case of obviousness.

Moreover, applicant respectfully submits that claim 14 is patentable over Madsen and Sheu, as claim 14 recite, *inter alia*, “**an annular connection member extending...from the air vent valve to the vicinity of the bottom of the bottle.**” Applicant submits that the annular connection member extending downward from the air vent valve, as recited in claim 14, is not shown in Madsen and Sheu, alone or in combination.

In rejecting claim 14, the Office Action indicates that Madsen does not disclose an annular connection member, much less an annular connection member extending downward from the air vent valve (the present Office Action, page 5, paragraph 6). However, the Office Action implies that an annular connection member extending downward from the air vent valve is disclosed in Sheu as the Office Action indicates “[t]o have added an annular extension to the valve to vent air towards the bottom of the bottle would have been obvious in view of” Sheu.

Applicant respectfully submits that Madsen, as noted by the Office Action, simply shows a baby bottle containing an air valve.

Meanwhile, Sheu discloses a baby bottle containing an extension tube 622 that extends from an intake hole 621. Applicant respectfully submits that the intake hole shown in Sheu is not equivalent to the air valve shown in Madsen (compare the air intake hole 621 and 622 in Figure 2A and 2B of Sheu and the air valve in Figure 10 and 12 of Madsen). As such, Sheu does not teach or suggest adding an extension tube to the end of the air valve.

Therefore, if the extension tube 622, as shown in Sheu, is added to Madsen, the extension tube 622 is not added to the air valve. In other words, two references, if combined, teaches, at best, a baby bottle comprising an air valve, an air intake hole 621, and extension tube 622 extending from the air intake hole 621. The combination does not show a baby bottle containing **“an annular connection member extending...from the air vent valve to the vicinity of the bottom of the bottle,”** as recited in claim 14. The references, therefore, do not render claim 14 obvious.

Furthermore, applicant respectfully submits that claim 14 is patentable over Madsen and Sheu, as there is no reason or suggestion to combine Madsen and Sheu.

The Federal Circuit held that in addition to the teaching requirement noted above, **there**

must be some teaching, suggestion, or motivation to combine the references when a rejection depends on a combination of prior art references (*In re Rouffet*, 149 F.3d at 1355 (citing *In re Geiger*, 815 F.2d 686, 688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987))). In search of the suggestion or motivation, **the Office Action cannot rely on the hindsight based on the invention or the “high level skill in the art to overcome the difference between the [features] and the selected elements in the references to provide the necessary motivation** (id. at 1357-1358).

In combining the references, the Office Action does not provide a rational, suggestion, or motivation to combine the references. Instead, the Office Action simply indicates that it would have been obvious to combine the reference (the present Office Action, page 5).

Applicant respectfully submits that combining the two references because it would have been obvious to combine them, the Office Action relies on either the applicant's own disclosure or high level of the skill in the art for the motivation, the reliance which the Federal Circuit expressly prohibits (*In re Rouffet*, 149 F.3d at 1357-1458). Therefore, applicant respectfully submits that the rejection on claim 14 is improper.

For all foregoing reasons, applicant respectfully submits that claim 14 is not *prima facie* obvious over Madsen in view of Sheu. Applicant respectfully requests withdrawal of the present rejection on claim 14.

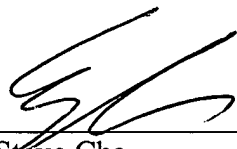
Other claims in this application are each dependent on the independent claim 14 and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

Amendment
Serial No. 10/687,071

Should the Examiner deem that there are any issues which may be best resolved by telephone, please contact Applicant's undersigned representative at the number listed below.

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